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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/963,526

09/27/2001

Shinji Tomita

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06/05/2006

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WASHINGTON, DC 20036

EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/963,526

Applicant(s)

TOMITA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 3, 4, 6 and 8.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Callie E. Shosho  
Primary Examiner  
Art Unit: 1714

**Attachment to Advisory Action**

1. Applicants' amendment and 1.132 declaration filed 5/15/06 have been fully considered, however, they are not persuasive. It is the examiner's position that Blum et al. (U.S. 6,706,801) remains a relevant reference against present claims 3-4, 6, and 8.

It is noted that applicants state on page 5 of the amendment filed 5/15/06 that in order to demonstrate unexpected and superior results, applicants have submitted 1.132 declaration. However, the 1.132 declaration filed 5/15/06 appears to be identical to the previous 1.132 declaration filed 11/29/05 and thus, it is not clear what, if any difference, there is between the two declarations. Clarification is requested.

It is noted that Blum et al. disclose coating method as presently claimed wherein the method uses coating composition wherein the ratio of isocyanate group in the polyisocyanate to 1 equivalent of hydroxy group in the acrylic resin is 0.5-2 while the present claims require ratio of 2.2.

Previously, the examiner argued that that the instantly claimed ratio and that taught by Blum et al. are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties".

In light of the case law cited above and given that there is only a “slight” difference between the ratio disclosed by Blum et al. and the ratio disclosed in the present claims, it is the examiner’s position that it would have been obvious to one of ordinary skill in the art that the ratio disclosed in the present claims is but an obvious variant of the ratio disclosed in Blum et al., and thus, one of ordinary skill in the art would have arrived at the claimed invention.

In response, applicants have filed 1.132 declaration that compares coating method comprising coating of the present invention, i.e. wherein ratio of isocyanate group in the polyisocyanate to 1 equivalent of hydroxy group in the acrylic resin is 2.2, with coating method comprising coating outside the scope of the present claims, i.e. ratio of isocyanate group in the polyisocyanate to 1 equivalent of hydroxy group in the acrylic resin is 2.0. It is shown that the presently claimed coating is superior in terms of coating performance, i.e. surface gloss, and substrate shielding ability.

However, it is the examiner’s position that the data is not persuasive given that there does not appear to be a significant difference between the coating within the scope of the present claims (coating I) and coating outside the scope of the present claims (coating II). That is, coating I is rated as having “good” gloss wherein “no influence” of paper scratch is observed while coating II is rated as having “slightly” lowered gloss wherein “slight influence” of paper scratch is observed. Thus, the only differences between the coating I and coating II are “slight” in terms of surface gloss and substrate shielding ability. It is not clear what, if any, difference there is between “good gloss” and “slightly” lowered gloss and “no influence” of paper scratch and “slight influence” of paper scratch. The results provided are not successful in establishing unexpected or surprising results over Blum et al. given that from the declaration, it cannot clearly

be determined what or how significant the differences are between the presently claimed coating and that of Blum et al.

Further, it is noted that the specification as originally filed does not disclose that the ratio of isocyanate group in the polyisocyanate compound to 1 equivalent hydroxyl group in the acrylic resin effects the coating performance or gloss. In fact, there does not appear to be any disclosure of coating performance or gloss in the present specification. The courts have upheld that a “basic property or utility must be disclosed in order for affidavit evidence of unexpected properties to be offered,” *In re Davies et al.*, 177 USPQ 381 (CCPA 1973). There is no disclosure regarding coating performance or gloss in the present specification. Thus, the results regarding coating performance are not persuasive.

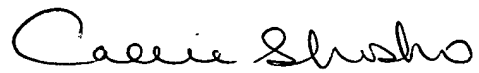
Applicants argue that the declaration filed 5/15/06 shows that the coating of the present invention having equivalent ratio of 2.2 NCO/OH exhibits unexpected and superior results in both coating performance and substrate shielding ability in comparison with coating having equivalent ratio of 2.0 NCO/OH as disclosed by Blum et al.

However, as stated above, it is not clear that the results set forth in Table 1 of the declaration are unexpected and superior given that it cannot be clearly determined what or how significant the differences are between the presently claimed coating and comparative coating. Applicants statement that the results are unexpected and superior is conclusionary. There is no evidence of how the results set forth in the declaration are unexpected and superior given that the difference between the presently claimed coating and the comparative coating, i.e. coating outside the scope of the present claims but within the scope of Blum et al., is only “slight”.

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Applicants have established no connection between the conclusion that the results are unexpected and superior and the results set forth in the declaration that show that the difference between the inventive coating and the comparative coating is only "slight".

It is noted that if applicants were to disclose how and why the results set forth in the declaration are unexpected and superior, i.e. discuss the difference between the inventive coating wherein no influence of paper scratch is observed (O rating) and comparative coating wherein "slight" influence of paper scratch is observed ( $\Delta$  rating) and how such difference is significant, the examiner would be willing to reconsider the rejection of record.

  
Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
6/1/06